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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,803	01/14/2004	James McSwiggen	MBHB03-465-C (400.142)	5421
20306 7590 12/21/2006 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER BOWMAN, AMY HUDSON	
			ART UNIT	PAPER NUMBER
			1635	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/757,803

Applicant(s)

MCSWIGGEN ET AL.

Examiner

Amy H. Bowman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/14/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed 10/5/2006 has been considered. Rejections and/or objections not reiterated from the previous office action mailed 6/12/2006 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

With entry of the amendment filed on 10/5/06, claims 18-20 and 33-38 are pending in the application.

Drawings

As notated on the office action mailed on 5/31/2005, the replacement drawings filed on 1/14/2004 are objected to. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d), as explained below. Although the drawing sheets were submitted on the filing date of the application, it is unclear which of the drawings are intended to be currently pending. Applicant submitted drawings labeled Figures 1-81 and drawings labeled Figures 77-81 on the same day. If applicant intends for the drawings labeled Figures 77-81 to replace the drawings labeled Figures 1-81, the sheets must be clearly labeled.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Response to Priority

The instant claims are accorded the priority date of 2/20/2002, which is the filing date of application 60/358,580, because application PCT/US03/05346 and application 60/358,580 each teach each of the limitations of claims 18-20 and 33-38.

Response to Claim Rejections - 35 USC § 103

Applicant's arguments filed on 10/5/2006 are acknowledged. However, the arguments pertain to the previous rejection that has been obviated by the amendments to the claims filed on 10/5/2006. The new rejection under 35 U.S.C. 103(a) below is necessitated by the amendments.

New Objections/ Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33-35 recite the limitation "the sense strand" in the double stranded nucleic acid molecule of claim 18. There is insufficient antecedent basis for this limitation in the claim because claim 18 does not recite a "sense strand".

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Claims 36 and 37 recite the limitation "said antisense strand" in the double stranded nucleic acid molecule of claim 18. There is insufficient antecedent basis for this limitation in the claim because claim 18 does not recite an "antisense strand".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elbashir et al. (The EMBO Journal, 2001, Vol. 20, No. 23, pages 6877-6888), in view of Matulic-Adamic et al. (US 5,998,203), Parrish et al. (Molecular Cell, Vol. 6, pages 1077-1087, 2000), and Crooke (US 5,898,031).

The invention of the above claims is drawn to a chemically synthesized double stranded nucleic acid comprising a first and a second strand, wherein the first strand comprises a sense region and the second strand comprise an antisense region, each strand is about 18 to about 27 nucleotides in length, about 18 to about 23 nucleotides of each strand are complementary to each other, and at least 18 nucleotides of the second strand are complementary to a target RNA sequence, and the first strand comprises a terminal cap moiety at the 5' and 3' end and the second strand includes a terminal cap moiety at the 3' end. The invention is further drawn to specific terminal cap moieties, as

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well as modifications to the duplex and a composition comprising the double stranded nucleic acid and a pharmaceutically acceptable carrier or diluent.

Elbashir et al. (EMBO) teach siRNAs, wherein each strand is 21-23 nucleotides in length and wherein at least 19 nucleotides of the sense strand are complementary to the antisense strand. Elbashir et al. teach chemical modification with 2'-deoxy or 2'-O-methyl modifications. Elbashir et al. teach modification of 19% of the nucleotides of a duplex 21 nucleotides in length with 2'-deoxy modifications.

Elbashir et al. teach duplexes with 2 nt 3' overhangs, as well as blunt ended duplexes wherein all 21 nucleotides are complementary between the sense and antisense strand. Elbashir et al. teach that duplexes 21 nucleotides in length with 2 nt 3' overhangs were the most efficient triggers of sequence-specific mRNA degradation. Elbashir et al. teach duplexes wherein the sense and antisense strands are complementary at 19 or 21 nucleotide positions (see for example, Figure 1D (1st duplex) and Figure 1F (1st duplex)). Elbashir et al. teach 2'-deoxythymidine in the 3' overhang (see page 6884). The 100% modified duplex taught by Elbashir et al. is considered to not comprise ribonucleotides.

Elbashir et al. do not teach double stranded nucleic acid molecules comprising the instantly recited terminal cap moieties and do not teach 2'-deoxy-2'-fluoro modifications. Elbashir et al. do not teach a composition comprising the double stranded nucleic acid molecule and a pharmaceutically acceptable carrier.

Matulic-Adamic et al. teach chemical modifications of double stranded nucleic acid structures. The enzymatic RNA molecules of Matulic-Adamic et al. are taught to be

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targeted to virtually any RNA transcript and achieve efficient cleavage (see column 1) and to be sufficiently complementary to a target sequence to allow cleavage. Matulic-Adamic et al. teach the incorporation of chemical modifications at the 5' and/or 3' ends of the nucleic acids to protect the enzymatic nucleic acids from exonuclease degradation, which improves the overall effectiveness of the nucleic acid, as well as facilitates uptake of the nucleic acid molecules (see column 2). Matulic-Adamic et al. teach base, sugar and/or phosphate modification, as well as terminal cap moieties at the 5'-cap, 3'-cap, or both. Specifically, 3' phosphorothioates, inverted abasic moieties, and 2'-O-methyl modifications are utilized. Matulic-Adamic et al. teach 2'-deoxy nucleotides and 2'-deoxy-2'-halogen nucleotides, wherein Br, Cl and F are representative halogens (see column 3, for example). For example, figure 3 contains a ribozyme structure that encompasses modification of at least 20%, at least 30%, at least 40% or at least 50% of the nucleotide positions, as well as the modifications instantly claimed. The modifications can be in one or both of the strands and can be modifications of different types within the same structure.

Matulic-Adamic et al. teach that preferred caps include 4', 5'-methylene nucleotides, 1-(beta-D-erythrofuransyl) nucleotides, 4'-thio nucleotides, 1,5-anhydrohexitol nucleotides, L-nucleotides, threo-pentofuransyl nucleotides, acyclic 3', 4'-seco nucleotides, 3,4-dihydroxybutyl nucleotides, 3,5-dihydroxypentyl nucleotides, 3'-3'-inverted nucleotide moieties, 3'-3'-inverted abasic moieties, 3'-2'-inverted nucleotide moieties, 3'-2'-inverted abasic moieties, 5'-5'-inverted nucleotide moieties, and 5'-5'-

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inverted abasic moieties (see columns 3 and 4, for example). Matulic-Adamic et al. teach compositions comprising the nucleic acid and reaction buffer, which is a diluent.

Parrish et al. teach a chemically synthesized siRNA molecule, wherein each strand is 26 bp in length. Additionally, Parrish et al. teach a 742 nt long dsRNA with complete modification with 2'-deoxy-2'-fluoro modifications, which was necessarily cleaved into dsRNA duplexes 21 nt in length.

Crooke teaches gapmer oligonucleotide chemistry and teaches that gapmer strategies increase oligonucleotide affinity to the target RNA (see column 9, for example). Crooke teaches chemical modifications that are incorporated to improve pharmacokinetic binding, absorption, distribution or clearance properties of the compound, affinity or specificity of the compound to target RNA, or modification of the charge of the compound (see column 7, for example).

Crooke teach that a particularly useful 2'-substituent group for increasing the binding affinity is the 2'-fluoro group (see column 12). Crooke also teaches 2'-O-methyl modifications.

It would have been obvious to synthesize a double stranded nucleic acid molecule with the structural characteristics taught by Elbashir et al. (EMBO), wherein the molecule is formulated in a composition with a diluent, as taught by Matulic-Adamic et al. It would have been obvious to incorporate the specific modifications taught by Parrish et al. and Matulic-Adamic et al.

One would have been motivated to synthesize a double stranded nucleic acid molecule, as taught by Elbashir et al. (EMBO), wherein the molecule is formulated in a

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composition with a diluent, because Matulic-Adamic et al. teach successful inhibition of target gene expression with nucleic acid molecules formulated in a diluent.

One would have been motivated to synthesize a double stranded nucleic acid molecule, as taught by Elbashir et al. (EMBO), with the modifications taught by Parrish et al. and Matulic-Adamic et al. because each of the modifications were known in the art to protect nucleic acids from exonuclease degradation, which improves the overall effectiveness of the nucleic acid, as well as facilitates uptake of the nucleic acid molecules, as taught by Matulic-Adamic et al. Additionally, Parrish et al. and Matulic-Adamic et al. teach extensive chemical modification of long dsRNA and ribozymes, respectively, with successful inhibition of target gene expression.

Since Elbashir et al. (EMBO), Matulic-Adamic et al., and Parrish et al. teach modified double stranded nucleic acid molecules that inhibit target gene expression, and Crooke teaches gapmer oligonucleotide chemistry to improve pharmacokinetic properties of the oligonucleotide, one would have been motivated to synthesize duplexes, as taught by Elbashir et al., with each of the instantly recited modifications, as taught by Elbashir et al., Matulic-Adamic et al., and Parrish et al. in order to optimize the activity of the molecule, as taught by Crooke.

Additionally, antisense oligonucleotides, ribozymes, and dsRNAs are each commonly used for sequence-specific mRNA knockdown and each of these encounters the same problems for effective application. Therefore, one would have been motivated to utilize the same modifications and techniques that have been utilized to overcome

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these problems with antisense oligonucleotides or ribozymes with siRNAs to add the same benefits to RNAi technology.

For example, Crooke teaches that gapmer oligonucleotide chemistry has provided antisense oligonucleotides with increased target affinity and pharmacokinetic properties. Crooke teaches that different modifications at different regions of the oligonucleotide have been tested in order to optimize oligonucleotide activity. Crooke teaches stepwise experimentation of modifications throughout oligonucleotides in order to find the optimal configuration. Crooke is relied upon as evidence that it is common to experiment with different known modifications at different locations to optimize oligonucleotide activity.

Therefore, one would have been motivated to apply such a method to incorporate known modifications at various locations and amounts, as taught by Crooke, into the siRNA duplexes that were synthesized by Elbashir et al.

Finally, one would have a reasonable expectation of success given that each of the modifications were known in the art at the time the invention was made to add benefits to antisense oligonucleotides, ribozymes or siRNA duplexes, as evidenced by Elbashir et al., Matulic-Adamic et al., Parrish et al. and Crooke, wherein each of the molecules face the same challenges, and each of which can be improved with modifications. Since Crooke teaches effectively walking modifications across antisense oligonucleotides to optimize the location of the modifications and activity of the oligonucleotide and Elbashir et al., Matulic-Adamic et al., and Parrish et al. teach successfully synthesizing modified double stranded nucleic acid molecules, one would

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reasonably expect for each of the modifications to benefit the double stranded nucleic acid molecules of Elbashir et al. as well. Furthermore, the long chemically modified dsRNA taught by Parrish et al. further demonstrate that extensively modified dsRNA molecules result in activity. Since Elbashir et al., Matulic-Adamic et al., and Parrish et al. teach extensive modification of double stranded nucleic acid molecules and Crooke teaches experimentally determining optimal locations and levels of modification of antisense oligonucleotides, incorporating each of the modifications in the double stranded nucleic acid molecules of Elbashir et al. is considered within the realm of routine optimization.

It is noted that Elbashir et al. teach that 100% modification of one or both strands with 2'-deoxy or 2'-O-methyl modifications abolished activity. However, regardless of the results of these specific modifications at 100% of the positions of one or both strands, Elbashir et al. did modify duplexes and published data regarding successful inhibition with some duplexes and unsuccessful inhibition with others, supporting that testing of such known chemical modifications is routine in the art. The results of Elbashir et al. are considered to offer motivation to incorporate chemical modifications at various percentages to optimize the activity of the duplex because not all modifications result in activity at every percentage.

Thus in the absence of evidence to the contrary, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy H. Bowman whose telephone number is 571-272-0755.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance.

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Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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